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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,492	05/17/2005	Hyung-Nam Choi	0112740-1078	3927

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EXAMINER

GOETZE, SIMON A

ART UNIT PAPER NUMBER

2631

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/535,492	Applicant(s) CHOI ET AL.	
	Examiner Simon A. Goetze	Art Unit 2631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 27 March 2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Woodward et al. (US Patent Application Publication # 2004/0203685)** in view of **Alperovich et al. (US Patent # 5,819,180)**.

Consider **claim 13**, Woodward et al. discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing at least one item of access information, wherein the access information comprises at least one first item of identification information for the mobile radio communication system *(included as part of the 3G phone system that is used – Page 2, Paragraph 20)* and at least one second item of identification information for a local area network,

wherein the second item of identification information comprises a first item of network information indicating the location of the local area network *(service manager 205 decides what services are available based upon location – Page 3, Paragraph 32)*,

and wherein the second item of identification information comprises a second item of network information indicating the type of the local area network *(connection managers 212-213 maintain information how the networks are to exchange information – Page 3, Paragraph 33)*, and

wherein the second item of identification information comprises a third item of network information indicating at least one service provided by the local area network *(service manager 205 maintains a list of the services available – Page 3, Paragraph 29; additionally service server 220 is capable of providing one or more services – Page 3, Paragraph 34)*.

However, Woodward et al. fails to disclose that at least one item of this information is stored on a terminal of a mobile radio communication system.

In related prior art, Alperovich et al. discloses that a SIM card inserted in a mobile phone is used to store a location area identifier (LAI) which stores information about networks the phone was connected to when the phone is powered off (*Column 5, Lines 36-42*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Alperovich et al. with those of Woodward et al. in order to store the information on the user's device to enable the phone to determine its availability of service based on its location.

Consider **claim 14**, Woodward et al. as modified by Alperovich et al. further discloses that the second item of identification information comprises a fourth item of network information uniquely identifying the local area network (*read as when the service server 220 notifies the service manager 205 when it is able to provide a service – Page 3, Paragraph 35*).

6. **Claims 16-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Woodward et al. (US Patent Application Publication 2004/0203685)** in view of **Alperovich et al. (US Patent 5,819,180)**, further in view of **Russell (US Patent Application Publication 2004/0249915)**.

Consider **claim 16**, as applied to claim 14 above, Woodward et al. as modified by Alperovich et al. fails to disclose that the fourth item of network information is encoded by a means of a maximum of five decimal digits.

In related prior art, Russell discloses that the fourth item of network identification, which uniquely identifies the local area network, is a maximum of five decimal digits (*read as the end user device which can provide access to WLANs contains a preferred roaming list (PRL) which*

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is a list of five-digit System identification Numbers (SIDs) which are unique for the service area of the provider – Page 1, Paragraph 4 and Page 2, Paragraph 20).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Russell with those of Woodward et al. combined with Alperovich et al. in order to store all unique identifiers in a five digit form to provide a standardized method of identifying networks and manage the amount of storage space required to store the identifiers.

Consider **claim 17**, as applied to claim 13 above, Woodward et al. as modified by Alperovich et al. fails to disclose that the second items of identification are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network.

In related prior art, Russell discloses that Preferred Roaming Lists (PRLs) are common in current networks and are roaming agreements set up with contracted service providers. If the service provider has a contract with the alternate provider, the System Identification Number (SIDs) would allow the user roam in that particular area.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Russell with those of Woodward et al. modified by Alperovich et al. to take advantage of the network identification stored on the terminal in order to control operation on different networks without requiring user intervention.

Consider **claim 18**, as applied to claim 14 above, Woodward et al. as modified by Alperovich et al. fails to disclose that the second items of identification are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network.

In related prior art, Russell discloses that Preferred Roaming Lists (PRLs) are common in current networks and are roaming agreements set up with contracted service providers. If the service provider doesn't have a contract with the alternate provider, the System Identification Number (SIDs) required would not be stored on the mobile terminal, and the user would not be allowed to connect to the alternate network.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Russell with those of Woodward et al. modified by Alperovich et al. to take advantage of the network identification stored on the terminal in order to control operation on different networks without requiring user intervention.

7. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Woodward et al. (US Patent Application Publication 2004/0203685)** in view of **Alperovich et al. (US Patent 5,819,180)**, further in view of **Shaheen et al. (US Patent Application Publication 2004/0228312)**.

Consider **claim 19**, as applied to claim 13 above, Woodward et al. as modified by Alperovich et al. discloses that first item of access information is stored on a device serving for user identification (*SIM module taught by Alperovich et al. – Column 5, Lines 36-42*).

In related art, Shaheen et al. teaches a system that marries UMTS phone service with a WLAN and that this access information can be stored on a USIM module (*mobile station identifier that is forwarded to the UMTS receiver is from the mobile station, and UMTS phone systems use USIM modules as a means for mobile station identification – Page 1, Paragraph 6*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Shaheen et al. with those of Woodward et al. as modified by Alperovich et al. in order to implement the functionality of identifying networks available to a mobile user on a UMTS system.

8. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Woodward et al. (US Patent Application Publication 2004/0203685)** in view of **Alperovich et al. (US Patent 5,819,180)**, further in view of **Heutschi (US Patent Application Publication 2004/0176092)**.

Consider **claim 15**, as applied to claim 13 above, Woodward et al. as modified by Alperovich et al. fails to disclose that the first, second, and/or third items of network information are encoded by means of a maximum of three decimal digits.

In related art, Heutschi discloses a system where the Mobile Country Code (MCC), which could be used to determine the location of a local area network, is comprised of three digits (*Page 3, Paragraph 21*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Heutschi with those of Woodward et al. modified by Alperovich et al. in order to store the identifiers in a three digit form to provide a

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standardized method of identifying networks and manage the amount of storage space required to store the identifiers.

Conclusion

9. The prior art made of record and not relied upon and is considered pertinent to applicant's disclosure is listed below.

US 5,475,689	Kay et al.	Cellular Telephone with Datagram and Dispatch Operation
US 5,572,528	Shuen	Mobile Networking Method and Apparatus
US 6,295,276	Datta et al.	Combining Routers to Increase Concurrency and Redundancy in External network Access
US 2002/0024937	Barnard et al.	Radio Communication System
US 6,359,711	Cole et al.	System and method for Supporting a Worker in a Distributed Work Environment
US 2002/0085516	Bridgelall	Automatic and Seamless Vertical Roaming Between Wireless Local Area Network (WLAN) and Wireless Wide Area Network (WWAN) While Maintaining an Active Voice or Streaming Data Connection: Systems, Methods and Program Products
US 2002/0123335	Luna et al.	Method and Apparatus for Provisioning a Mobile Station Over a Wireless Network
US 6,526,034	Gorsuch	Dual Mode Subscriber Unit for Short Range, High rate and Long Range, Lower Rate Data Communications
US 2003/0142641	Sumner et al.	Managing Wireless Network Data
US 2004/0122954	Shaheen	Method and System for User Initiated Inter-Device, Inter-System, and Inter-Internet Protocol Address Handoff

US 2004/0248615	Purkayastha et al.	Wireless Communication Components and Methods for Multiple System Communications
US 2005/0101329	Gallagher	Apparatus and Method for Extending the Coverage Area of a Licensed Wireless Communication System Using an Unlicensed Wireless Communication System
US 2005/0177733	Stadelmann et al.	Method and System for GSM Authentication During WLAN Roaming
US 6,963,555	Brenner, II et al.	Method and System for Authorization, Routin, and Delivery Transmissions

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10. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Simon A. Goetze whose telephone number is (571) 270-1113. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm and Friday from 7:30am to 4:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Simon A. Goetze
S.A.G./sag

July 24, 2006

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Ed Orgad 7/24/06